

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kazutaka Nakamoto et al.

Application No.: 10/573,890

Confirmation No.: 9930

Filed: March 29, 2006

Art Unit: N/A

For: NOVEL ANTIFUNGAL AGENT
CONTAINING HETEROCYCLIC
COMPOUND

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL
REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE
1.114 RCE APPLICATION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- ☒ a. Copies of cited U.S. patents and patent application publications are not included.
Copies of foreign patent documents and non-patent literature are included.

☐ b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

☐ c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) but for which copies are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Appl. No(s) and U.S. Filing Date

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

☐ a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.

☒ b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows: **WO 02/04626A1, US 5,852,042, EP 1229034, WO 02/060875, WO 02/060896, WO 03/068232, WO 2004/029027 and WO 2004/000813A1 are cited in the present specification.**

An English language abstract is attached to each of JP 7-25853, WO 86/03203 A1, JP 3-161470, JP 54-2325, JP 2002-275159, WO 03/059903 A2, WO 99/48492 A1, WO 01/25181 A1, WO 98/25883 A1 and JP 2000-178243.

JP 2000-504336 corresponds to US Patent No. 6,313,127; JP 2003-506466 corresponds to US Patent No. 6,630,495; JP 61-148178 corresponds to US Patent No. 4,720,493; JP 59-206353 corresponds to EP 124067 A1; JP 1-246264 corresponds to US Patent No. 5,296,484; JP 10-505600 corresponds to WO96/09294 A1; and JP 3-66689 corresponds to US Patent Nos. 5,034,393 and US 5,350,749.

☐ c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(III)(A)(3).

☐ d. OTHER - The following additional information is provided for the Examiner's consideration.

IV. FEES (check one box)

☐ a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.

☐ b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.

☐ c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required. *(This section is not to be used with RCE's.)*

☐ d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.

☐ e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.

☒ f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).

☐ g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

☐ No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.
or

☐ See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

☐ a. **Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or**

☐ b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or

☐ c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any

individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

☐ d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

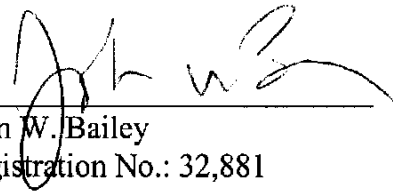
- ☐ The required fee is listed on the attached Fee Transmittal.
- ☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: JUL 6 2006

Respectfully submitted,

By 
John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment(s):

- ☒ PTO-SB08
- ☒ Documents
- ☐ Foreign Search Report
- ☐ Fee
- ☐ Other:

Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete If Known	
				Application Number	10/573,890-Conf. #9930
				Filing Date	March 29, 2006
				First Named Inventor	Kazutaka Nakamoto
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	1	of	2	Attorney Docket Number	3939-0118PUS1

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
	AA*	US-5,296,484-A	03-22-1994	Coghlan et al.	
	AB*	US-5,852,042	12-22-1998	Jakobi et al.	
	AC*	US-5,945,431	08-31-1999	Jin et al.	
	AD*	US-6,080,767	06-27-2000	Klein et al.	
	AE*	US-5,710,171	01-20-1998	Dinsmore et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	BA	JP-2000-504336-A	04-11-2000			
	BB	JP-2003-506466-A	02-18-2003			
	BC	JP-7-25853-A	01-27-1995			
	BD	JP-61-148178-A	07-05-1986			
	BE	JP-3-161470-A	07-11-1991			
	BF	WO-02/083645-A1	10-24-2002			
	BG	WO-03/045385-A1	06-05-2003			
	BH	JP-59-206353-A	11-22-1984			
	BI	JP-1-246264-A	10-02-1989			
	BJ	JP-54-2325-A	01-09-1979			
	BK	JP-10-505600-A	06-02-1998			
	BL	JP-3-66689-A	03-22-1991			
	BM	WO-02/04626-A1	01-17-2002			
	BN	EP-1229034-A1	08-07-2002			
	BO	WO-02/060875-A1	08-08-2002			
	BP	WO-02/060896-A1	08-08-2002			
	BQ	WO-03/068232-A1	08-21-2003			
	BR	WO-2004/029027-A1	04-08-2004			
	BS	WO-2004/000813-A1	12-31-2003			
	BT	WO-97/28128-A1	08-07-1997			
	BU	WO-02/22583-A2	03-21-2002			
	BV	WO-01/11966-A1	02-22-2001			
	BW	WO-86/03203-A1	06-05-1986			
	BX	EP-0124067-A1	11-07-1984			
	BY	WO-96/09294-A1	03-28-1996			
	BZ	EP-0414386-A1	02-27-1991			
	BA1	JP-2002-275159-A	09-25-2002			
	BB1	WO-03/059903-A2	07-24-2003			
	BC1	WO-99/48492-A1	09-30-1999			
	BD1	EP-1275653-A1	01-15-2003			
	BE1	EP-1275301-A1	01-15-2003			
	BF1	WO-01/74779-A1	10-11-2001			
	BG1	WO-02/060898-A1	08-08-2002			
	BH1	DE-19727117-A1	01-07-1999			
	BI1	WO-01/25181-A1	04-12-2001			

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>			Complete if Known		
			Application Number	10/573,890-Conf. #9930	
			Filing Date	March 29, 2006	
			First Named Inventor	Kazutaka Nakamoto	
			Art Unit	N/A	
			Examiner Name	Not Yet Assigned	
Sheet	2	of	2	Attorney Docket Number	3939-0118PUS1

	BJ1	WO-00/73283-A1	12-07-2000		
	BK1	WO-98/25883-A1	06-18-1998		
	BL1	WO-01/53274-A1	07-26-2001		
	BM1	WO-00/07991-A1	02-17-2000		
	BN1	WO-01/27096-A1	04-19-2001		
	BO1	WO-00/51998-A1	09-08-2000		
	BP1	WO-01/21584-A1	03-29-2001		
	BQ1	JP-2000-178243-A	06-27-2000		
	BR1	WO-98/50029-A1	11-12-1998		
	BS1	EP-0274867-A2	07-20-1988		
	BT1	WO-02/06275-A1	01-24-2002		
	BU1	EP-0533130-A1	09-16-1992		
	BV1	EP-0976744-A1	02-02-2000		
	BW1	EP-1217000-A1	06-26-2002		
	BX1	WO-97/27852-A1	08-07-1997		
	BY1	WO-02/00651-A2	01-03-2002		
	BZ1	WO-93/12084-A1	06-24-1993		
	BA2	WO-99/50247-A1	07-10-1999		
	BB2	WO-00/62778-A1	10-26-2000		
	BC2	WO-01/51456-A2	07-19-2001		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. * CITE NO.: Those application(s) which are marked with an single asterisk (*) next to the Cite No. are not supplied (under 37 CFR 1.98(a)(2)(iii)) because that application was filed after June 30, 2003 or is available in the IFW. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS					
Examiner initials	Cite No. ¹	include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			T ²
	CA	SHINKAI et al., J. Med. Chem., Vol. 31, pp. 2092-2097, (1988).			
	CB	OKAWA et al., Synthesis, pp. 1467-1475, (1998).			
	CC	OHSHIMA et al., J. Med. Chem., Vol. 35, pp. 3402-3413, (1992).			

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
--------------------	--	-----------------	--